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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,743	04/18/2000	Roger P. Jackson	99.198	2761

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[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3738

DATE MAILED: 07/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/552,743	Roger Jackson
	Examiner Brian E Pellegrino	Art Unit 3738

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 06 May 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 31-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 31-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### **Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### **Attachment(s)**

15) Notice of References Cited (PTO-892)                  18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)                  19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                  20) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 31,32 are rejected under 35 U.S.C. 102(e) as being anticipated by Biedermann et al. (6176882). Biedermann discloses apparatus for stabilizing spinal vertebrae. The implant (Fig. 1) has a posterior wall where a post **15** is mounted **7'**. It can also be seen there are upper and lower walls **60,61** that has an expansion member **45** which operably urges upper and lower walls to a different angle. It can be interpreted that face **3** is a cover with upper and lower support surfaces and has a fastener **25** mechanism.

Claims 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Koros et al. (5980522). Figs. 15 and 16 illustrate apparatus for stabilizing the spine anteriorly. Koros et al. disclose (Figs. 15, 16) an expansion cap **450** coupled with the implant. It can be interpreted that element **470** is an end cover that is operably secured to the implant via rod **408**. Regarding claim 34, Fig. 16 shows a fastener **470** that is received in a recess of the cap. With respect to claim 35, Fig. 12 shows an implant body **350** having a plurality of apertures **363, 361** and a chamber **358**.

Claims 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Nolan (6117174). Nolan discloses a cylindrical implant (Figs. 4,5,16) having an end cover **14'**, Figs. 12, 13. Fig. 17 shows the end cover **14'** with upper and lower flat surfaces engaging vertebrae.

Claims 40,41 are rejected under 35 U.S.C. 102(b) as being anticipated by Lahille et al. (5554191). Fig. 6 illustrates an implant with an upper wall 311, lower wall 321 and a posterior wall 33. It can also be seen there is a post 36 mounted in the posterior wall. Fig. 15 shows a fastener 363. Lahille also discloses an expansion member 37 coupled to the post.

***Response to Arguments***

Applicant's arguments filed 1/10/02 and 5/06/02 have been fully considered but they are not persuasive. In response to Applicant's argument that the Koros implant contains additional structure not required by Applicant's invention, it must be noted that Koros discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant. Claims in a pending application are to be given their broadest reasonable interpretation. *In re Hyatt*, 54 USPQ2d 1664 (Fed. Cir. 2000). Therefore, Koros anticipates new claim 33 since the anterior end of the implant is expandable and the fact that the posterior end does also is just an additional feature of Koros, not claimed by applicant. In response to applicant's argument that Lahille is inserted differently (posteriorly) and the same for Nolan, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino  
TC 3700, AU 3738  
July 18, 2002

*Brian Pellegrino*

  
David Willse  
Primary Examiner